

REMARKS

1. Claims 33 and 34 were rejected under 35 USC 102(b) as anticipated by Stegmann (US 5486165).
2. Claim 33 has been amended to clarify that the microcannula based microsurgical device is inserted into the segment of Schlemm's Canal that has been previously expanded using the flexible microcannula. By contrast, in the Stegmann reference, the second tube 20' is configured as a mirror image of the first tube 20 so that it can be inserted into a different segment of Schlemm's Canal. (Column 4, lines 42-49.) The configuration of the second tube 20' makes it unsuitable for insertion into the same segment of Schlemm's Canal that was previously occupied by the first tube 20. (See FIG. 8.)

Claim 34 further distinguishes Stegmann by the novel step of "removal of tissues from the inner wall of Schlemm's Canal." Stegmann does not disclose the removal of tissues from within Schlemm's Canal. The only direct manipulation of tissue that occurs in Stegmann is the initial incision that is made in order to gain access to Schlemm's Canal. (See FIGS. 3 and 4.) A flap 13' is made, but no tissue is removed. Furthermore, the incision is made from the scleral surface, therefore the flap 13' is made on the *outer wall* of Schlemm's Canal, rather than the *inner wall*.

Claims 33 and 34 are therefore submitted to be patentable over Stegmann (US 5486165) under 35 USC 102(b).

3. Examiner stated that claim 35 was rejected under **35 USC 102(b)** as anticipated by Stegmann (US 5486165) in view of Grieshaber (US 2002/0013546).
4. This is an improper rejection under 35 USC 102(b) because references cannot be combined under this statute. Examiner is requested to withdraw the rejection or to clarify the rejection in a subsequent *non-final* Office Action.

However, in order to hasten prosecution and allowance of the claims, Applicant points out that claim 35 distinguishes both Stegmann and Grieshaber by the novel features recited in base claim 33, namely that the microcannula based microsurgical device is inserted into the

segment of Schlemm's Canal that has been previously expanded using the flexible microcannula. Furthermore, since neither reference discloses this novel feature, no possible combination of the two references could result in the claimed invention.

5. Claims 30-31 were rejected under 35 USC 103(a) as unpatentable over Stegmann (US 5486165) in view of Rainin (US 5599330) or John (US 2004/0122352).

6. Applicant respectfully traverses the rejection of claims 30-31. Examiner erroneously states that Stegmann utilizes suction in the disclosed method; however there is no mention of suction anywhere in the reference. The section cited by Examiner (column 3, lines 23-29) has nothing to do with the application of suction. Stegmann is actually describing the natural flow of aqueous humour within the eye, as shown in FIG. 2. Applicant notes that there are not even any devices present within the eye shown in FIG. 2 that could apply the fictitious suction alleged by Examiner. Applicant contends that Examiner would never have made this misinterpretation of the reference without the hindsight provided by applicant's own patent application.

There is no suggestion or motivation in the Stegmann reference to apply suction through any part of the disclosed apparatus. Furthermore, applicant points out that Rainin and John both disclose devices that apply suction to the *exterior* of a patient's eye. There is no suggestion or motivation in these secondary references to apply suction through a device that is inserted into Schlemm's Canal within the eye.

Examiner's rejection was based on an erroneous interpretation of the primary reference. Without this misinterpretation, there is no suggestion or motivation to combine the references as proposed by Examiner. Examiner is respectfully requested to withdraw the rejection of claims 30-31.

7. Claim 32 was rejected under 35 USC 103(a) as unpatentable over Stegmann (US 5486165) in view of Rainin (US 5599330) or John (US 2004/0122352) and further in view of Bylsma (US 2006/0221078).

8. As with claims 30-31 above, Examiner's rejection was based on an erroneous interpretation of Stegmann, the primary reference. Without this misinterpretation, there is

no suggestion or motivation to combine Rainin or John with Stegmann, as proposed by Examiner. For this reason, Examiner is respectfully requested to withdraw the rejection of claim 32.

Furthermore, as pointed out in reference to claim 34 above, Stegmann does not disclose the removal of material from within Schlemm's canal as erroneously stated by Examiner. There is no suggestion or motivation to combine from Bylsma because it is directed to an entirely different approach to treating glaucoma. Rather than repairing Schlemm's canal to establish normal drainage, Bylsma seeks to bypass the normal drainage pathway by installing a glaucoma drain 100 to drain aqueous humour externally. Without Examiner's misinterpretation of the primary reference, there is no suggestion or motivation to combine the tissue cutting device of Bylsma with Stegmann. For this additional reason, Examiner is also requested to withdraw the rejection of claim 32.

9. New claims 36-64 are submitted to be patentable over the prior art of record for the reasons stated above and by virtue of the additional novel and unobvious features recited therein. No new matter has been added.

CONCLUSION

For all the reasons above, Applicant submits that the claims all define novel subject matter that is nonobvious. Therefore, allowance of these claims is submitted to be proper and is respectfully requested.

Applicant invites the Examiner to contact Applicant's representative as listed below for a telephonic interview if so doing would expedite the prosecution of the application.

Very respectfully submitted,

/James J. Leary/

James J. Leary
GSS Law Group
3900 Newpark Mall Rd
Third Floor, Suite 317
Newark, CA 94560

Reg. No. 35,237
Phone (510) 742-7417
Fax (510) 742-7419
Direct phone (636) 600-0255